

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Jim HUNTER, et al.	)	Confirmation No: 2175
	)	
Application No.: 10/050,994	)	Group Art Unit: 2872
	)	
Filed: January 22, 2002	)	Examiner: Alessandro V. Amari

For: HIGH CONTRAST GRATING LIGHT VALVE

**Mail Stop Appeal Briefs - Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**APPELLANTS' REPLY BRIEF**

Sir:

This is in response to the Examiner's Answer mailed September 16, 2008. In replying herein, Appellants expressly carry forward the arguments advanced in their Brief on Appeal, and incorporate them herein. For the sake of brevity, they are not repeated. Rather, this Reply focuses on arguments advanced in the Examiner's Answer that are respectfully submitted to be inconsistent with the record, or inconsistent with the law.

I. **THE SOLE ISSUE ON APPEAL IS WHETHER THE DEVICE CLAIMED WAS IN FACT TESTED AND FOUND TO WORK FOR THE INTENDED PRUPOSE PRIOR TO THE CIRITCAL DATE**

Appellants' claims stand rejected over a reference available only under 35

U.S.C. §102(e)/103 – U.S. Patent No. 6,233,087, **Hawkins**, which issued as a U.S. Patent some three months after Applicants' effective filing date of March 8, 2001. Applicants, relying on multiple Declarations and exhibits explained in those Declarations, rely on a demonstration that the invention claimed was conceived of, made and reduced to practice prior to the effective date of the reference, which is December 18, 1998.

The Examiner's Answer concedes that competent evidence has been submitted to demonstrate that in fact the Applicants conceived of and made the invention claimed prior to December, 1989. See page 12 of that Answer (*[T]he issue at hand is whether the declarations submitted are effective to overcome the Hawkins reference by showing reasonable diligence as evidenced by actual reduction to practice*). Answer, page 12, lines 8 – 10. See also, page 7.

Respectfully, this is a misstatement of the law, as diligence is not at issue. Applicants assert an actual reduction to practice prior to the availability of **Hawkins** as a reference. Nonetheless, the Answer does make it clear that the sole issue for review on this Appeal is whether or not Applicants have made out a *prima facie* showing that in fact the device claimed was tested and demonstrated to work for its intended purpose, in this case, as a Grating Light Valve, demonstrating the ability to modulate reflected light.

**II. THE TESTIMONY OF THE INVENTORS AND CORROBORATOR IS THAT THE DEVICE WAS SUCCESSFULLY TESTED PRIOR TO THE CRITICAL DATE**

Repeatedly in the Examiner's Answer, the argument is offered that the testimony "indicates some confusion and ambiguity as to when the testing of the claimed device actually occurred." See the Answer, page 13, lines 6 – 8, page 14, lines 12 – 13, page 15, lines 4 – 6. Quite simply, the Examiner has mischaracterized the evidence. The primary evidence in this case, as it must be pursuant to 37 C.F.R. §1.131, is the Declaration of the inventors and witnesses. In three separate declarations, the affirmative statement appears from both inventors and corroborators that in fact the device of the claims was made and tested, and shown through that testing to modulate reflected light, in advance of December, 1998.

The Declaration of James Hunter dated July 25, 2005 is Exhibit E to Appellants' Brief. In paragraphs 5 – 10 and Exhibit B to that Declaration, Hunter confirms that in fact, following the process developed to make the subject matter of the invention, prior to December, 1998, the subject matter of Claim 1 was in fact made by him and co-inventors. See paragraph 11 (*[T]he subject matter of Claim 1 can be produced and was produced at Silicon Light Machines prior to December 1989 (sic, 1998)*). While the Examiner questions whether in fact the device bore a conductive trace, see the Answer, page 13, lines 1 – 5, in point of fact, the Declaration that is Exhibit E specifically notes that the device made prior to December 1998 in fact had a conductive trace, paragraphs 9 – 10. See also, Exhibit B to the Declaration, lines 21 and 22. As to this device, Hunter states, clearly and unambiguously:

As can be seen, accordingly, by performing the process set forth in the runsheet as was done at Silicon Light Machines by me and individuals working with me and under my direction, the subject matter of Claim 1 can be produced and was produced at Silicon Light Machines prior to December 1989. Moreover, as tested to the satisfaction of myself and my co-inventors, these grating light valves were shown to modulate the amount of light reflected by them from a light source, thereby demonstrating that the grating light valves made prior to August 11, 1989, by myself and co-inventors, in fact “worked for the intended purpose” in that they showed utility as grating light valves.

Exhibit E to Appellants’ Brief, paragraph 11. Hunter was in no way confused as to when these events occurred (In his Declaration with David Amm, Exhibit F to the Brief, Hunter acknowledges that the date advanced should be corrected to read from 1989 to 1998, paragraph 2).

The Declaration of Hunter and Amm of April 9, 2007 is Exhibit F to Appellants’ Brief on Appeal. It too unambiguously confirms the testing of the subject matter of Claim 1 prior to the effective date of the reference. It recites:

The device was tested to our satisfaction, the grating light valves shown to modulate the amount of light reflected down by them from a light source, under application of an electric field, and further shown to work as intended by dissipating any electric charge that would otherwise have been trapped in the dielectric through the conductive trace provided. Although the testing reflected in Exhibit A hereto cannot be described, by us, within a certainty to have occurred prior to December, 1998, it is reflective to the testing that did occur, as we recall, prior to December , 1998 at Silicon Light Machines.

Exhibit F to Appellants’ Appeal Brief, paragraph 5.

Appellants also rely on the corroborating Declaration of Doug Webb, Exhibit G to the Appeal Brief. Webb testifies in paragraph 2, that he was at Silicon Light Machines during the relevant time frame. Webb further testifies that:

I recall testing of this type of grating light valve being conducted at Silicon Light machines prior to December, 1998. I have reviewed Exhibit A attached to the Declaration of

Hunter and Amm, which is a three page document bearing the title “0-order Charging.” I cannot be certain whether or not the testing reflected therein is in fact testing that was conducted prior to December, 1998, but it is certainly reflective of the kind of testing done, prior to December, 1998, testing that demonstrated modulation of reflected light in response to application of electric fields, and dissipation of charges built up in the dielectric layer through the provision of a conductive trace on that layer. This was a device successfully tested at Silicon Light Machines, prior to December, 1998. The testing was conducted, to the best of my memory, as part of a program to determine whether such devices could be developed for commercial practice.

Exhibit G in support of Appellants’ Appeal Brief, paragraph 3.

There is simply is no confusion or ambiguity as suggested by the Examiner. Time after time, inventors and corroborators confirmed that prior to the effective date of **Hawkins**, the device of Claim 1, bearing a conductive trace, was tested at Silicon Light Machines, and shown to be effective in modulating reflected light and dissipating accumulated charges – that is, shown to “work for its intended purpose.”

**III. THE EXAMINER’S REQUIRMENT FOR CONTEMPORANEOUS RECORDS IS NOT REASONABLE**

As noted in Appellants Opening Brief, pages 14 – 15, while it is desirable to provide documentary evidence of the events and things described in the Declarations submitted pursuant to 37 C.F.R. §1.131, it is not a requirement. Yet the Examiner persisted in the rejection, disregarding the sworn statements of the inventors and corroborators as not enough, insisting that “objective evidence” be presented, See, e.g., the Office Action of June 26, 2007.

For more than 150 years our law has emphasized that documents are good and valuable, but not required for this type of showing, if they are not available. The clear and unequivocal

statements of the inventors should be accepted, absent some reason to doubt them. *Ex parte Donovan*, 1890 C.D. 109, *Ex parte McGuckian*, 202 USPQ 398, 399 – 400 (BPAI 1975). The Examiner does not disagree.

In an effort to satisfy the requirement of the Examiner for contemporary documents, Applicants provided documents that showed the type of results obtained pursuant to the pre-December 1998 testing they clearly recalled. The hitch? They could not be certain that the actual data captured by these documents were indeed produced by the tests that occurred before December, 1998, as opposed to similar tests conducted later. They were careful to say so – in every case, they said that the testing did occur before December, 1998, that this is the type of testing that was conducted, but the exact date of the specific run shown was unknown. This does not somehow render their direct testimony unclear, vague or unreliable. All that Applicants were attempting to demonstrate, since the Examiner doubted their clear testimony, was what kind of testing it was that was done.

In Exhibit F to the Brief on Appeal, Hunter and Amm describe the specific efforts made to find contemporaneous documents that both reflected the testing done before December, 1998, and could be positively verified as done before that date. Exhibit F, paragraph 4. None could be found. Our law recognizes this may be the case, and so requires the presentation of contemporaneous documents or “their absence must be satisfactorily explained.” Appellants have explained that the records of a small company from 10 years ago and more, that was subsequently acquired, are simply unavailable. There is no basis to reject the clear and precise testimony of the witnesses presented. Accepting that testimony requires the rejection of the claims based on **Hawkins**, alone, or considered in light of a secondary reference, be reversed. The same is respectfully requested.

#### IV. CONCLUSION

The burden on Applicants is one of a *prima facie* showing. The evidence that is contemplated by the rules is testimony by Declaration. 37 C.F.R. §1.131. That testimony has been submitted, and is clear and unequivocal. Applicants supplemented that testimony with documents that showed what type of testing was done to demonstrate that the invention unquestionably made at Silicon Light Machines by the inventors prior to the effective date of the reference was in fact, prior to the critical date, shown to be useful for the intended purpose. The fact that the witnesses cannot be absolutely certain as to the date of the documents and events reflected therein, while they ARE certain as to the fact that the testing was conducted prior to December, 1998, does not somehow introduce a lack of clarity, or somehow render vague that which is crystal clear. Having presented the type of evidence called for, that demonstrates far more likely than not, an actual reduction to practice of the claimed invention was made by Applicants prior to December, 1989, the burden shifts back to the Examiner to demonstrate the clear testimony presented is not reliable. The Examiner has provided no contrary evidence. The invention of the claims was not only made, but tested and shown useful for the intended purpose, prior to the effective date of the principal reference. The rejection over **Hawkins** should be reversed.

Respectfully submitted,

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